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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,184	04/23/2001	John Anthony Lucas	8257.15USWO	6598
23552	7590	08/09/2004	EXAMINER	
MERCHANT & GOULD PC			HERTZOG, ARDITH E	
P.O. BOX 2903			ART UNIT	
MINNEAPOLIS, MN 55402-0903			PAPER NUMBER	

1754

DATE MAILED: 08/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

S.C.

Office Action Summary

Application No.

09/786,184

Applicant(s)

LUCAS ET AL.

Examiner

Ardith E. Hertzog

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 Apr 2001, 17 May 2001 & 4 Jun 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-39 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restriction

1. Restriction is required under 35 U.S.C. §§ 121 and 372:

This application contains the following groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. In accordance with 37 CFR § 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted:

Group I, claims 1-18, 28 and 39, drawn to:

Soil remediation processes and corresponding apparatuses, wherein the contaminants are thermally desorbed and then combusted in a thermal oxidiser, **wherein combustion air and desorbed contaminants are preheated by heat exchange with the offgases of the thermal oxidiser.**

Group II, claims 19-27 and 29-38, drawn to:

Soil remediation processes and corresponding apparatuses, wherein the contaminants are thermally desorbed and then combusted in a thermal oxidiser, **wherein the desorbed contaminants are at least in part combusted within the desorption chamber and then the contaminants are treated in the thermal oxidiser in at least two stages.**

2. The inventions listed as **Groups I** and **II** do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features, as discussed *supra*. That is, the special technical feature of **Group I** relates to the combustion air and desorbed contaminants being preheated by heat exchange with the offgases of the thermal oxidiser, while the special technical feature of **Group II** relates to the partial combustion and then treatment of the contaminants in the thermal oxidiser in at least two stages.

Thus, as stated in the corresponding International Search Report for the “parent” application in this 35 U.S.C. § 371 application:

These groups are not so linked as to form a single general inventive concept, that is, they do not have any common inventive features, which define a contribution over the prior art. The common concept linking together these groups of claims is a process and apparatus for remediating soil wherein the contaminants are thermally desorbed then combusted in a thermal oxidiser. However[,] this concept is not novel in the light of [the following documents, each cited by applicant in either the Information Disclosure Statement (IDS) filed May 17, 2001, or the IDS filed June 4, 2001]:

US 4 974 528 A (BARCELL) 4 December 1990 see claim 1
US 5 378 083 A (SWANSON) 3 January 1995 see claim 3 and column 3[,] line 55 – column 4[,] line 29
DE [OS] 3 447 079 A (STILL) 6 March 1986 see [claims 1 and 18]...

Therefore[,] these claims lack unity a posteriori. (“Continuation of Box IV” of Form PCT/IPEA/409 (Supplemental Sheet) for PCT/AU99/00785)

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR § 1.143).
4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR § 1.48(b) and by the fee required under 37 CFR § 1.17(i).

Conclusion

5. Any inquiry concerning this communication should be directed to Ardith E. Hertzog at telephone number (571) 272-1347. The examiner can normally be

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reached on Monday through Friday (from about 8:30 a.m. - 4:30 p.m.).

6. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley S. Silverman, can be reached at (571) 272-1358. The fax phone number for the organization where this application is assigned is 703-872-9306.

7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. For any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



AEH
July 29, 2004



STANLEY S. SILVERMAN
SUPERVISORY PATENT EXAMINER
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